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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/982,426	10/18/2001	Peter Wierach	64251-034	6662

7590 12/22/2003
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EXAMINER

BUDD, MARK OSBORNE

ART UNIT	PAPER NUMBER
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2834

DATE MAILED: 12/22/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Corrected

Office Action Summary

Application No.

09/982,426

Applicant(s)

WIERACH, PETER

Examiner

Mark Budd

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 October 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 3, 4, 6 and 8-30 is/are pending in the application.
- 4a) Of the above claim(s) 13-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 3, 4, 6, 8-12 and 21-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: |

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This is a corrected office action

Claims 1, 3, 4, 6, 8-12 and 21-30 are rejected under 35 USC 103 as unpatentable over Iten or Lazarus in view of Ovorsky or Crawley.

Iten (figs. 1, 2, & 6) and Lazarus (fig. 2A-C) teach an electrode piezo element laminated between insulating sheets with lead electrodes thereon and a spaces layer. They do not explicitly use a fiber reinforced insulator or some of the particular electrode materials claimed. However, both Dvorsky and Crawley teach using fiber reinforced insulating encapsulation materials to increase the strength of piezoelectric transducers. The specific wire mesh and woven fabric electrode materials are known per se (official notice taken). Since it has long been held that selection from among known suitable materials is within the skill expected of the routineer, use of these specific materials based on their known attributes would have been obvious to one of ordinary skill in the art. This a repeat of the previous rejection.

Applicant have disagreed with the examiners statement that woven elastic is a well known suitable electrode material for piezoelectric devices. The examiner is surprised by this disagreement since applicants presumably work in the piezoelectric art on a daily basis. However, as required by MPEP 2144.03 the following are cited as evidence of the "official notice" that 'woven elastic' is a well known electrode material: Stein, Zimmnick, Bast, Bindig, Pelrine and Reidel.

Applicants have stated that the office action has not provided any reason for combining the references. However, the rejection clearly states increased strength as at least one motivation.

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Applicant states that the amendments are unrelated to the patentability of the claims. It must be pointed out that original claim 1 was not limited to using a woven elastic material.

This application contains claims 13-20 drawn to an invention nonselected with traverse in Paper No. '1202' (restriction). A complete reply to the final rejection must include cancellation of nonselected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

Claim provisionally rejected under the judicially created doctrine of double patenting over claim of copending Application No. . This is a provisional double patenting rejection since the conflicting claims have not yet been patented.

The subject matter claimed in the instant application is fully disclosed in the referenced copending application and would be covered by any patent granted on that copending application since the referenced copending application and the instant application are claiming common subject matter, as follows:

Furthermore, there is no apparent reason why applicant would be prevented from presenting claims corresponding to those of the instant application in the other copending application. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

Buddick

10/24/03